

REMARKS

The present Amendment is in response to the Office Action dated May 1, 2006 in reference to the above-identified application. The Examiner set a shortened statutory period for reply of three (3) months, making the present Amendment due by August 1, 2005. Filed concurrently herewith is a request for a three-month extension of time so that the present Amendment is due by November 1, 2006.

In that Office Action, claims 1-36 were pending. Of these, claims 1, 2, 5-8, 12-15, 18, 19, 21, 22, 30-32 and 36 were rejected as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 6,055,832 to Wyers in combination with any of U.S Patent No. 4,651,543 to Heald et al, U.S Patent No. 5,156,029 to Heald, and U.S Patent Publication No. US2004/0211230 to Recknagel. Claims 3, 4, 16, 17, 20 26-29, 34 and 35 were rejected as obvious under 35 U.S.C. §103(a) over Wyers in view of any of Heald et al (543), Heald (029) or Recknagel in further view of U.S Patent No. 6,467,316 to Chen. Claims 9-11, 23-25 and 33 were rejected as obvious under 35 U.S.C. §103(a) over Wyers in view of any of Heald et al (543), Heald (029) or Recknagel in further view of U.S Patent No. 6,402,181 to Lee.

Claims 1, 18, 30 and 36 have been generally been amended so that each includes, according to their respective specific language (the exact recitation varying according to the context of the respective claim), that the locking head has an outer surrounding sidewall surface and a transverse inner face. The "head cover" includes two portions--a "cover portion" or "skirt" that extends only along the outer surrounding sidewall surface so as to engage the sidewall

surface and secure thereto, and a “flange portion” that extends inwardly of the cover portion. The flange portion has an opening through which the latch portion of the shackle shank may be inserted with the edge of the flange providing a seal against the shank. In addition, corresponding amendments have been made to various dependent claims, and some dependent claims have been canceled, to comport with the amendments to the independent claims.

The amended structure is not believed to be fully and fairly disclosed in the references applied by the Examiner, whether taken alone or in combination. While Wyers (832) shows the general structure to which the present invention is, in some respects, an improvement, The seal in the exemplary embodiment of Wyers is provided by an internal O-ring. Heald et al (543) teaches a cover that completely covers a padlock body. This cover includes a bottom portion that encloses the outer end face of the padlock body. Heald (029) is quite different in utilizing a two-part cover. The upper cap 58 of the cover in Heald (029) engages the lower portion 32 and interlocks therewith to secure around the padlock body. The published application to Recknagel shows an entirely different structure that that now recited by the amended language.

In addition, Applicant respectfully suggests that the Examiner has applied hindsight reasoning to combine the applied references based on the teachings of the present application. Indeed, the Examiner has now done a new, third search to now, for the first time in a third office action, locate and apply the Heald et al and Recknagel references. This appears to be a case where the Examiner has

chosen to merely locate disparate structures in disparate references and then opine that a combination of the same would be obvious.

While the Examiner has alleged a “motivation” for combining these references, the claimed motivation is “to also seal and protect the outer periphery of the locking head of Wyers, to prevent scratching and damage thereto when in use>” (See, Office Action, page 3) The purpose of the head cover of the present invention is to provide a seal in lieu of the O-ring of Wyers (832). Moreover, Applicant’s counsel has reviewed the applied references for any suggestion of this motivation, and has found none. Therefore the applied references do not appear to provide this motivation and the same may therefore be improperly premised again on the teachings of the present application itself.

A *prima facie* case of obviousness cannot be established without a basis for combining or modifying the applied references. (M.P.E.P. §2143.01). There is no such suggestion in the applied references. The only suggestion is found in the present application. When the only suggestion to combine the teachings of the applied references in the manner proposed by the Examiner is found in the hindsight accorded one who first views the Applicant’s disclosure, an obviousness rejection under 35 U.S.C. §103 is improper. See *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

A *prima facie* case of obviousness requires that the prior art reference (or references when combined) teach or suggest all the claim limitations. *In re*

Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging patentability of that claim against the prior art."); MPEP §2143.03.

Accordingly, the Examiner has not established a *prima facie* case of obviousness because, in addition to failing to provide a motivation for combining the references, the references also fail to teach all of the limitations in at least amended claims 1, 18, 30, and 36. It follows that claims 1, 18, 30, 36 and all claims depending therefrom should be allowed.

Based on the foregoing and with all due respect to the Examiner's initial reading of the applied references, Applicant submits that the present application is in complete condition for allowance. Action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney or agent for the Applicant at the telephone number listed below.

No additional claims fees are believed to be payable upon the Amendment. However, the Commissioner is hereby authorized to charge any deficiency in the required fees, or to credit any overpayment, to deposit account number 13-1940.

Applicant submits that the present application is now in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is

requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

Respectfully submitted,

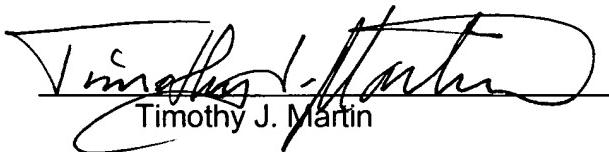
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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the foregoing **AMENDMENT** (16 pages) and **REQUEST FOR A THREE-MONTH EXTENSION OF TIME** (2 pages) is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 1st day of November, 2006.


Timothy J. Martin